



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
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OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

MEMORANDUM

TO: GROUP 3764 **DIRECTOR**

FROM: **BOARD OF PATENT APPEALS AND
INTERFERENCES**

SUBJECT: **ORDER REMANDING TO EXAMINER**

We are forwarding this application to your Group for taking further action consistent with the decision of the Board remanding this appeal to the Primary Examiner.

Program & Resource Administrator
Board of Patent Appeals and Interferences
308-9797

The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

Paper No. 21

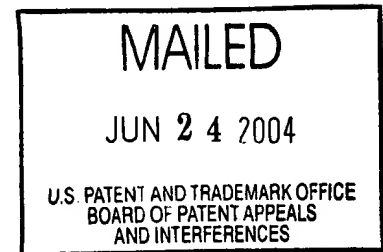
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte HELEN HARDMAN HOWLETT-CAMPANELLA

Appeal No. 2004-1351
Application No. 09/765,533

ON BRIEF



Before GARRIS, PAK and JEFFREY T. SMITH ***Administrative Patent
Judges***

JEFFREY T. SMITH ***Administrative Patent Judge***

REMAND TO THE EXAMINER

The following matters must be addressed before we reach the merits
of the issue on appeal.

1. The Campanella and Ferris declarations

Concurrently with the Brief, Appellant filed two declarations, one each from Campanella and Ferris, under 37 CFR § 1.132. See Paper No. 16, filed October 06, 2003. The Examiner in the Answer stated that “[t]his is in response to the appeal brief filed October 6, 2003.” However, the record is not clear whether the declarations have been entered. The Examiner provided no substantive response in the Answer to the points raised in the declarations. Nor is the record clear whether the contents of the declarations have been considered by the Examiner.¹

“In reviewing the examiner’s decision on appeal, the Board must necessarily weigh all of the evidence and argument. . . . [T]he ultimate determination of patentability is made on the entire record.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Since our review of the Examiner’s rejections will be based on all of the evidence in the record, the Examiner must make clear whether evidence, such as the Campanella and Ferris declarations, are properly part of the record on appeal.

¹ Appellant also acknowledges that the Examiner has not indicated that the declarations have been considered. (Reply Brief, p. 4).

On return of this application, the Examiner should clarify whether or not the Campanella and Ferris declarations, filed October 6, 2003 (Paper No. 16), have been entered.²

2. Response to Appellant's arguments

The Examiner has not provided a full and complete response to Appellant's arguments. Appellant in support of her position has presented a dictionary definition of the disputed term "marker". (Brief, p. 16). The record is not clear whether the Examiner has considered this newly presented evidence.

3. Drawings

In the response filed August 19, 2002, Appellant has indicated that modifications have been made to the drawings. The present record is not clear as to whether the amended drawings have been properly entered into the record and approved by the Examiner.

4. Future proceedings in this application

If the Examiner decides that the Campanella and Ferris declarations are entitled to entry, we authorize the Examiner to submit a Supplemental

² After a notice of appeal has been filed, evidence such as a Rule 132 declarations are not entered as a matter of right. See 37 CFR § 1.195 ("Affidavits, declarations, or exhibits submitted after the case has been appealed will not be admitted without a showing of good and sufficient reasons why they were not earlier presented."). In the present application the notice of appeal was filed August 11, 2003.

The Examiner should consider whether Appellant has satisfactorily explained their delay in submitting the Campanella and Ferris declarations. See Manual of Patent Examining Procedure (MPEP) § 1211.02 ("If such an affidavit or declaration is not accompanied by the showing required by 37 CFR § 1.195, the Examiner will not consider its merits. If the delay in filing such affidavit or declaration is satisfactorily explained, the Examiner will admit the same and consider its merits.").

Examiner's Answer to address Appellant's arguments drawn to the declarations. Also, we authorize the Examiner to submit a Supplemental Examiner's Answer to adequately address Appellant's newly presented evidence and clarify the status of the amended drawings. See MPEP § 716.01: "All entered affidavits, declarations, and other evidence traversing rejections are acknowledged and commented upon by the Examiner in the next succeeding action. . . . Where the evidence is insufficient to overcome the rejection, the Examiner must specifically explain why the evidence is insufficient. General statements such as 'the declaration lacks technical validity' or 'the evidence is not commensurate with the scope of the claims' without an explanation supporting such findings are insufficient."

Appellant is entitled to file a Supplemental Reply Brief in response to the Examiner's Supplemental Answer.

This application, by virtue of its “special” status, requires an immediate action. MPEP § 708.01 (8th ed., August 2001). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMANDED


BRADLEY R. GARRISS
Administrative Patent Judge


CHUNG R. PAK
Administrative Patent Judge


JEFFREY T. SMITH
Administrative Patent Judge

BOARD OF PATENT
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